



PATENT APPLICATION

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PATENT AND TRADEMARK OFFICE

BEFORE THE HONORABLE BOARD OF PATENT APPEALS AND INTERFERENCES

In re the Application of

On Appeal from Group: 3682

Henry ROSENTHAL

Application No.: 10/694,021

Examiner: V. LUONG

Filed: October 28, 2003

Docket No.: 116364

For: TAPERED GRIP FOR MOTORCYCLE HANDLEBAR

APPEAL BRIEF TRANSMITTAL

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

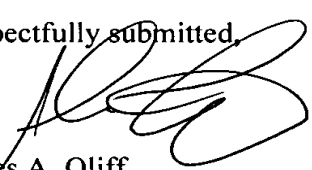
Sir:

Attached hereto is our Brief on Appeal in the above-identified application.

Also attached hereto is our Check No. 167704 in the amount of Two Hundred Fifty Dollars (\$250.00) in payment of the Brief fee under 37 C.F.R. 1.17(c). In the event of any underpayment or overpayment, please debit or credit our Deposit Account No. 15-0461 as needed in order to effect proper filing of this Brief.

For the convenience of the Finance Division, two additional copies of this transmittal letter are attached.

Respectfully submitted,


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BEFORE THE HONORABLE BOARD OF PATENT APPEALS AND INTERFERENCES

In re the Application of

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BRIEF ON APPEAL

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Appeal from Group 3682

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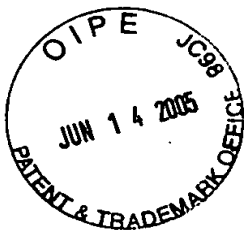


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I. REAL PARTY IN INTEREST

The real party in interest for this appeal and the present application is Renthal Limited, by way of an Assignment recorded in the U.S. Patent and Trademark Office at Reel 014644, Frame 0266.

II. STATEMENT OF RELATED APPEALS AND INTERFERENCES

There are no prior or pending appeals, interferences or judicial proceedings, known to Appellant, Appellant's representative, or the Assignee, that may be related to, or which will directly affect or be directly affected by or have a bearing upon the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 1-3 are on appeal.

Claims 1-3 are pending.

Claims 1-3 are rejected.

IV. STATUS OF AMENDMENTS

An Amendment After Final Rejection was filed on March 11, 2005. By an Advisory Action dated March 31, 2005, it was indicated that the requested amendments to the claims had been entered. Amendments to the Specification and the Figures were requested in the March 11 Amendment, but were not entered by the Examiner.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The present invention relates to a hand grip adapted to fit onto a motorcycle handlebar end section. This handgrip provide increased wear resistance in regions most susceptible to wear so that the grip will last longer before splitting or needing replacement. The configuration of the grip also provides enhanced comfort and vibration damping to the hands of a motorcycle rider (p. 2, lines 9-14). The configuration includes projections formed on the cylindrical body that progressively decrease in height from adjacent the flange to adjacent the opposing, second end (closed or open), so as to provide an external taper to the body (cl. 1, p. 2, lines 16-19).

The overall size of such projections, particularly their base areas, decrease from adjacent the flange to adjacent the second end. As a result, the external diameter of a hand grip in accordance with the invention may reduce by less than 5mm from adjacent the flange to adjacent the second end (cl. 2, p. 2, lines 21-23). The effect of this configuration results in prolonged life of the grip and increased comfort to the motorcycle rider.

The motorcycle hand grip has a hollow cylindrical body 10, an open end from which an annular flange 14 projects radially outwards, and an opposing end which may be closed by an end wall 12 (Figs. 1 - 3). An outer layer to the hand grip body 10 includes a raised pattern of adjoining rectangles 16 on one side of the body 10 and a pattern of surface projections 18 which are also present inside the boundary of the aforesaid rectangular pattern 16.

The projections 18 are generally in the form of a plurality of adjacent square pyramids, each having a diamond shaped base, i.e. its diagonal being axial relative to the cylindrical body 10 of the grip. The overall size of the respective pyramidal projections 18 decreases gradually from adjacent the flange 14 to adjacent the closed end (cl. 2). Thus, the diamond shaped bases decrease in area and the height of the projections also decreases which provides an overall taper to the external diameter of the body 10.

The taper does not need to be great to serve its purpose. For example, there may be an overall reduction in external diameter of only 2mm from adjacent the flange 14 to adjacent the closed end. By making the region adjacent the flange 14 somewhat thicker, particularly making the extra thickness from the softer rubber compound of the outer layer, extra cushioning of a rider's hand is provided in the region of greatest pressure and greatest wear, i.e. below the arch formed by thumb and forefinger. Also, because there is more material, this region does not wear down, split and fail as quickly as hitherto in the case of substantially constant external diameter grips.

The use of a gradual taper achieves these advantages without making the handgrip overall too thick for effective gripping/encircling by the rider's hand, as the region towards the closed end 12 is still of virtually the same external diameter as on conventional grips (p. 4, line 1 - p. 5, line 6).

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

The following grounds of rejection are presented for review:

- 1) Claims 1-3 are rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Design Patent D284,259 to Oury.

VII. ARGUMENT

The Office Action rejects all of pending claims 1-3 under 35 U.S.C. §103(a) as unpatentable over U.S. Design Patent D284,259 to Oury¹. The Office Action fails to give proper consideration to the factual inquiries required in determining obviousness.

A. Factual Inquiries to Determine Obviousness/Non-Obviousness

In rejecting claims under 35 U.S.C. §103, it is incumbent on the Examiner to establish a factual base to support the legal conclusion of obviousness. See, In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In doing so, the Examiner must provide the actual determinations as set forth in Graham v. John Deere Co., 383, U.S. 1, 17, 148 USPQ, 459, 467 (1966). The criteria set forth in Graham v. John Deere Co. include 1) some suggestion or motivation in either the references or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine the teachings; 2) a reasonable expectation of success, and 3) the combination must teach or suggest all of the claim features. These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note, In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The mere fact that the prior art may be modified in the manner suggested by the examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992).

The Office Action fails to give proper consideration to the factual inquiries set forth in Graham in formulating the rejection of claims 1-3. Proper consideration of the factual inquiries demonstrates nonobviousness of the pending claims.

¹ Although a number of other references are mentioned by the Examiner in the rejection, as discussed herein, the additional references are not part of the rejection per se.

B. Claims 1-3 Would Not Have Been Obvious Over U.S. U.S. Design Patent D284,259 to Oury

The primary reference of Oury discloses projections progressively increasing in height from adjacent the flange to adjacent the second area. In contrast, independent claim 1 recites projections progressively decreasing in height from adjacent the flange to adjacent the second end so as to provide an external taper to the body". Oury also discloses that a base area of the projections increases from adjacent the flange to the second end. In contrast, claim 1 recites a base area of the projections progressively decreasing.

It is alleged in the Office Action that it was "common knowledge" in the art at the time the invention was made to decrease, instead of to increase, the height of Oury's projections in order to maximize the amount of torque which may be transmitted from the rider to the grip. However, this assertion is nowhere supported by the record, is specifically contrary to the only cited reference, and thus is an improper basis for an obviousness rejection.

1. An Assertion of Common Knowledge Requires Evidentiary Support

The Examiner made the above 'common knowledge' rejection, but has no proper evidentiary support. Official Notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be...common knowledge are capable of instant and unquestionable demonstration as being well known. See MPEP §2144.03 citing In re Ahlert, 424 F.2d 1088, 1091, 165 USPQ 418, 420. "It is never appropriate to rely totally on 'common knowledge' in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based." See MPEP §2144.03 citing In re Zurko, 258 F.3d at 1385, 59 USPQ 2d at 1697. The Office Action fails to provide evidentiary support of the alleged common knowledge.

In what appears to be a Remarks section of the Final Rejection, it is alleged that uncited reference U.S. Design Patent D461,390 to Livingston "shows that the projections that decrease in height from adjacent the flange to adjacent the second end so as to provide an external taper to the body is well known." However, Livingston fails to disclose a hand grip comprising ... an annular flange projecting radially outwards at the first, open end, the cylindrical body also having an external surface formed with a plurality of projections distributed there over, the projections progressively decreasing in a base area and in height from adjacent the flange to the second end so as to provide an external taper to the body, as recited in the rejected claims.

Rather, as clearly shown in the figures of the design patent to Livingston, the base area increases from the flange and then decrease again at the second end. It also appears from the figures of Livingston that the height increases from the flange and then rapidly decreasing at the second end. Furthermore, there is no disclosure in Livingston that it is the projections which provide the external taper. Thus, the reliance on Livingston as showing that it is 'common knowledge' to have the structural features recited in the rejected claims fails.

In a further attempt to provide evidentiary support for the allegation of 'common knowledge', the Office Action relies on Figs. 2 and 3 of U.S. Patent 5,261,665 to Downey in the same Remarks section of the Final Rejection. However, Figs. 2 and 3 of Downey disclose elevational views of a die for forming a golf club grip socket. The golf club grip formed by the die disclosed in Downey has no annular flange as recited in the rejected claims, nor do the projections on the golf club grip die decrease in base area from adjacent a flange to adjacent a second end. Furthermore, the motorcycle hand grip recited in the rejected claims describe a hollow cylindrical body having a first open end and an annular flange projecting radially outwards at the first open end. Downey fails to disclose such an open end. Thus, Downey does not support the allegation in the Office Action that it is "common knowledge" to

decrease instead of increase the height of projections. As the assertion of 'common knowledge' is not based on proper evidence in the record, the assertion of 'common knowledge' must fail.

2. An Assertion of Design Choice is a Conclusion and Not a Statement of Fact

In rejecting claims 1-3 under 35 U.S.C. §103(a) it is alleged that although Oury's projections progressively increase, instead of decrease, in height from adjacent the flange to adjacent the second end, that the reversal/rearrangement of the height of Oury's projections would have been "a matter of choice in design since the claimed structures and the function they perform are the same as the prior art".

The mere fact that a worker in the art could rearrange the parts of a reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device. See MPEP §2144.04 citing Ex parte Chicago Rawhide Mfg. Co., 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984).

As Oury is a design patent, Oury merely contains figures. Thus, motivation to rearrange the parts of the Oury reference cannot be derived from the figures, which shows an arrangement exactly opposite of the claimed invention. Furthermore, as Oury merely discloses ornamentation on the handle grip, no function of such ornamentation can, or may be, implied in a design patent. By definition, a design application cannot claim a function, but rather is merely for ornamentation.

Second, the claimed decrease in height of the projections from adjacent the flange to adjacent the second end is not a design choice as the recited structural features aids rider comfort and provides greater wear resistance of the claimed hand grip. As recited in the

specification, "by making the region adjacent the flange 14 somewhat thicker, particularly making this extra thickness from the soft rubber compound, extra cushioning on the rider's hand is provided in exactly the region of greatest pressure and greatest wear, i.e., below the arch formed by thumb and forefinger. Also because there is more material, this region does not wear down, split and fail as quickly as hitherto in the case of substantially constant external diameter grips." Thus, the arrangement of the projections as recited in the claims is not merely design choice, but provides the structure necessary to overcome the deficiencies of known motorcycle hand grips.

3. Reliance on Design Patents in Rejecting Utility Patent Claims Under 35 U.S.C. §103 is Improper

It is alleged that it is proper to rely on the figures of a design patent in rejecting the claims of a utility patent as being obvious in view of the applied reference. In support of the allegation In re Mraz, 173 USPQ 25 (CCPA 1972) is cited. However, in setting forth the rejection, the Office Action misstates the holding of In re Mraz when alleging that the holding recites "drawings in a design patent can anticipate or make obvious the claimed invention" (emphasis added). Rather, the cited passage correctly recites that "drawings and pictures can anticipate claims if they clearly show the structure which is claimed" (MPEP §2125) (emphasis added). Thus, the reliance on the misstated holding of In re Mraz is improper as the figures in the design patent of Oury are relied upon to form the basis of an obviousness-type rejection, rather than to anticipate the claims as was the actual holding in In re Mraz.

Additionally, MPEP §2125 further recites that when relying on a figure to reject pending claims, "the picture must show all the claimed structural features and how they are put together". As Oury is merely a design patent, Oury fails to "show all the claimed structural features and how they are put together".

C. Claim 2 Would Not Have Been Obvious Over U.S. U.S. Design Patent D284,259 to Oury

1. An Assertion of Common Knowledge Requires Evidentiary Support

"It is never appropriate to rely totally on 'common knowledge' in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based." See MPEP §2144.03 citing In re Zurko, 258 F.3d at 1385, 59 USPQ 2d at 1697.

It is alleged that Oury teaches the invention substantially as claimed but for an external diameter of the cylindrical body being reduced by less than 5mm from adjacent the flange to adjacent the second end, as recited in claim 2. However, it is again alleged that the feature not provided by Oury is "common knowledge". As stated above, it is never appropriate to rely solely on common knowledge in the art without evidentiary support on the record. As no evidentiary support is provided, the Office Action fails to provide a proper rejection of claim 2.

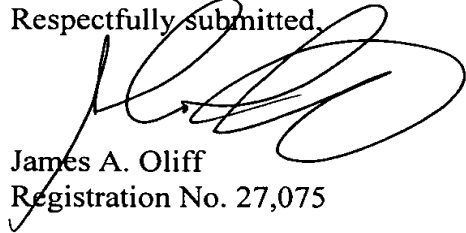
2. An Assertion of Design Choice is a Conclusion and Not a Statement of Fact

It is alleged that the size or dimension of the external diameter of the cylinder body, as recited in claim 2, would have been a matter of design choice since the claimed structures and the functions they performed are the same as the prior art. However, as the relied upon prior art is merely a design patent, there is no functionality in the pictures but rather, the design patent is for ornamental features only.

VIII. CONCLUSION

For all of the reasons discussed above, it is respectfully submitted that the rejections are in error and that claims 1-3 are in condition for allowance. For all of the above reasons, Appellants respectfully request this Honorable Board to reverse the rejections of claims 1-3.

Respectfully submitted,



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CLAIMS APPENDIX

CLAIMS INVOLVED IN THE APPEAL:

1. A hand grip adapted for non-rotatable fitting onto a motorcycle handlebar end section, the hand grip comprising:
 - a hollow cylindrical body having a first, open end;
 - an opposing, second end; and
 - an annular flange projecting radially outwards at the first, open end, the cylindrical body also having an external surface formed with a plurality of projections distributed there over, said projections progressively decreasing in a base area and in height from adjacent the flange to adjacent the second end so as to provide an external taper to the body.
2. (Original) A hand grip as set forth in claim 1 wherein the external diameter of the cylindrical body reduces by less than 5mm from adjacent the flange to adjacent the second end.
3. (Original) A hand grip as set forth in claim 1 wherein the second end is closed by an end wall.

EVIDENCE APPENDIX

None

RELATED PROCEEDINGS APPENDIX

None